



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/241,083	02/01/1999	HIROYUKI KOSUDA	1080.1071/JD	8170

21171 7590 07/14/2005

STAAS & HALSEY LLP
 SUITE 700
 1201 NEW YORK AVENUE, N.W.
 WASHINGTON, DC 20005

EXAMINER

RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/241,083	Applicant(s) KOSUDA ET AL.	
	Examiner Yehdega Retta	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is responsive to amendment filed April 25, 2005. Applicant amended claims 1-3, 7-10 and added new claim 11. Claims 1-11 are currently pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 11 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by View Source Magazine, "On-line Banking Through Navigator With Web@TM", March 1997 (hereinafter Web@TM).

Regarding claim 11, Web@TM teaches executing a transaction via an ATM machine responsive to a request by a user; displaying selectable options of providing a record of the executed transaction or past transaction to the user, the selectable options including transmitting the record to an electronic mail address and/or printing the record at the ATM machine and providing the record of the executed transaction or the past transaction in accordance with a selection made by the user from the displayed selectable options (see page 1 and see demo).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3622

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldsmith U.S. Patent No. 6,049,990, in view of View Source Magazine, On-line Banking Through Navigator With Web@TM, March 1997 and further in view of Takemura et al. JP 04372057 (admitted prior art).

Regarding claims 1 and 2, Goldsmith teaches an ATM machine comprising a display device; means for controlling the display; performing input operation in accordance with a display on the device (see fig. 1-3 and col. 2 line 45 to col. 4 line 65 and col. 6 line). Goldsmith teaches performing a transaction at an ATM machine and a host system electronically transmitting the transaction information to the user's location such as user's e-mail address, identified by user contact information (see col. 3 lines 48 to col. 4 line 55). Goldsmith teaches displaying at users computer, a selectable item in a dialog box requesting the user to update account data maintained by the application program with the recent account activity data provided in the notification message (see col. 8 lines 1-12). Goldsmith failed to teach an ATM screen display in which a destination electronic mail address for receiving a transaction record is able to be input through the input means and a screen display providing options to the consumer to choose from, the options being to transmit the transaction record to the destination address or print the transaction record at the facility. Web@TM teaches an ATM display device; means for controlling the display; performing input operation in accordance with a display on the device (see page 1), performing on the display device a screen display in which a destination electronic mail address for receiving a transaction record is able to be input through the input means and a screen display providing options to the consumer to choose from, the

Art Unit: 3622

options to transmit the transaction record to the destination address and to print the transaction record at the ATM device (see page 1). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to combine Goldsmith's teaching of ATM machine with delivery of transaction information to user's terminal via e-mail and Web@TM's teaching of entering of an e-mail address, at a transaction device, for the delivery of transaction information. One would be motivated to provide an option, at an ATM device, to update user notification information, as taught by Goldsmith, in order to provide a current address in which to deliver the transaction information. It is well known for an ATM machine to provide an option to print transaction information. Web@TM teaches an ATM display screen, displaying an option for account statements, reports or transaction receipts to be printed online or e-mailed to the customer (see page 1). Therefore it would have been obvious to one of ordinary skills in the art at the time of applicant's invention was made to modify Goldsmith's ATM system and Web@TM's ATM screen by including an option to print and transmit the receipt to an email address. One would be motivated to have the option of printing a paper receipt, in order to verify the transaction at the facility, and to receive electronic copy through electronic mail for the purpose of saving the information for later use, in case the paper receipt is lost. Goldsmith does not teach a third screen display to input a temporary destination electronic mail address, it is taught in Web@TM. It would have been obvious to one of ordinary skill in the art to modify Goldsmith's ATM system with Web@TM's virtual ATM display in order to provide an option for customer to receive the information at preferred location. Goldsmith does not teach a fourth screen display in which a number representing a number of transaction is input through the input means including a new transaction and past transaction. Web@TM teaches customer specifying

Art Unit: 3622

the number of current and previous transaction records to be transmitted and *number of transaction records including a new transaction record and past transaction records are displayed* (see Web@TM demo under statement selection). It would have been obvious to one of ordinary skill in the art to modify Goldsmith's ATM system with Web@TM's ATM display means in order to allow customers view their financial statements, such as transaction summary including new and old transactions, as taught by Web@TM (see page 1 par. 2 and 3). *Goldsmith teaches options being displayed responsive to the operation of the customer to perform the customer's desired transaction, but does not disclose the option comprising transmitting the transaction record to destination address. Takemura teaches an ATM machine display device for providing options for transmitting transaction records to destination address, printing the transaction address or both, wherein the selectable option being displayed responsive to the operation of the customer to perform the desired transaction (see abstract and also applicant background as admitted prior art). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the options of transmitting transaction records to destination addressed to be displayed responsive to the operation of the customer to perform the actions, as in Takemura since ATM screen display is limited, which prevent the system from displaying all options at the same time. One would also be motivated to transmit the record to an e-mail address instead to a Fax number address, as taught by Takemura, since e-mail provides a better communication means.*

Claims 7-9, recites similar limitation as claims 1 and 2, therefore the rejection of claims 1 and 2 applies.

Regarding claim 10, Goldsmith teaches an ATM machine comprising a display device; means for controlling the display; performing input operation in accordance with a display on the device (see fig. 1-3 and col. 2 line 45 to col. 4 line 65 and col. 6 line). Goldsmith teaches performing a transaction at an ATM machine and a host system electronically transmitting the transaction information to the user's location such as user's e-mail address, identified by user contact information (see col. 3 lines 48 to col. 4 line 55). Goldsmith teaches displaying at users computer, a selectable item in a dialog box requesting the user to update account data maintained by the application program with the recent account activity data provided in the notification message (see col. 8 lines 1-12). Goldsmith failed to teach an ATM device displaying selection option to transmit a transaction receipt to a destination address and both to transmit the transaction receipt and the print the receipt at the machine. It is well known for an ATM machine to provide an option to print transaction information. Web@TM teaches transaction device displaying selection options to transmit a transaction receipt to a destination address or print the transaction receipt at the customer transaction facility (see page 1). Therefore it would have been obvious to one of ordinary skills in the art at the time of applicant's invention was made to modify Goldsmith's transaction system with Web@TM's ATM display means by including an option to print and transmit the receipt to an email address. One would be motivated to have the option of printing a paper receipt to verify the transaction, and to receive electronic copy through electronic mail for the purpose of saving the information for later use, in case the paper receipt is lost. Goldsmith teaches transmitting the transaction receipt to pre-selected address however does not specifically teach display options to transmit the transaction receipt to a different address, it is taught in Web@TM. One would be motivated to send the transaction

Art Unit: 3622

receipt to a different location, in order to be able to receive the information at convenient location, such as the office computer, laptop or palm or home computer. Goldsmith does not teach entering the number of transaction that could be transmitted. Web@TM teaches specifying the number of transactions, previous and current, to be transmitted (see Web@TM under statement selection). It would have been obvious to one of ordinary skill in the art to modify Goldsmith's transaction system with Web@TM's ATM display means in order to allow customers view their financial statements, as taught by Web@TM (see page 1 par. 2 and 3). *Goldsmith teaches options being displayed responsive to the operation of the customer to perform the customer's desired transaction, but does not disclose the option comprising transmitting the transaction record to destination address. Takemura teaches an ATM machine display device for providing options for transmitting transaction records to destination address, printing the transaction address or both, wherein the selectable option being displayed responsive to a transaction request by a user (see abstract and also applicant background as admitted prior art). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the options of transmitting transaction records to destination addressed to be displayed after a transaction request by as user, as in Takemura, since ATM screen display is limited, which prevent the system from displaying all options at the same time.*

Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldsmith U.S. Patent No. 6,049,990, in view of Takemura et al. JP 04372057 (admitted prior art) and further in view of View Source Magazine, On-line Banking Through Navigator With Web@TM, March 1997.

Regarding claims 3-6, Goldsmith teaches a display device; a display control means for controlling the display; input means for performing an input operation in accordance with the display; a screen display of customer-selectable options of transmitting the transaction record to the destination address, printing the record or both (see fig. 1-3 and col. 2 line 45 to col. 4 line 65 and col. 6 line). Goldsmith teaches a screen display, at a user computer, for inputting a destination e-mail address; wherein when the consumer inputs an electronic mail address the communication control means transmits the input to host computer to be register in association with the transaction information file for customers; communication control means for controlling communication to a host computer; wherein the display control means causes the display to display payment option when a transaction is performed through an operation of the input means in accordance with the transaction options the display control means display a screen display of options comprising option to transmit the transaction record to an electronic mail address (see col. 8 lines 1-67). Goldsmith failed to teach an ATM machine display device displaying an option for inputting destination e-mail address to be registered at a host computer and opting for inputting a new destination address for the transaction record. Takemura teaches an ATM machine display device for inputting a destination FAX number to be registered at a host computer and to enter a FAX number other than the registered address (see abstract and also applicant background as admitted prior art). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to combine Goldsmith's teaching of forwarding transaction information to an e-mail address and Takemura's teaching of entering a destination address at an ATM machine. One would be motivated to provide an option to enter e-mail address at the ATM machine instead of Fax number as taught by Takemura, since e-mail

Art Unit: 3622

provides a better communication means. Goldsmith does teach screen display to input a number representing a number of transaction record to be transmitted. Web@TM teaches specifying the number of transactions, previous and current, to be transmitted (see Web@TM under statement selection). It would have been obvious to one of ordinary skill in the art to modify Goldsmith's transaction system with Web@TM's ATM display means in order to allow customers view their financial statements, as taught by Web@TM (see page 1 par. 2 and 3). It is well know for an ATM machine to provide an option to issue the transaction record in the form of a sheet. It would have been obvious to have the option of printing a paper receipt in order to verify the transaction. *Goldsmith teaches options being displayed responsive to the operation of the customer to perform the customer's desired transaction, but does not disclose the option comprising transmitting the transaction record to destination address. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the options of transmitting transaction records to destination addressed to be displayed responsive to the operation of the customer to perform the actions since ATM screen display is limited which prevent the system from displaying all options at the same time.*

Response to Arguments

Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

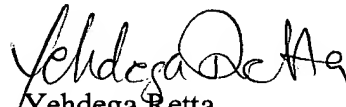
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 3622

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yehdega Retta
Primary Examiner
Art Unit 3622

YR